

REMARKS

This is in response to the Non-Final Office Action of March 1, 2006.

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mizzi (US 4147284: 4/3/79). According to the Examiner, Mizzi teaches a two-part aerosol dispenser comprising a nozzle, pressure chamber (cylinder), needle and pump. See column 2 line 40 - Column 3 line 45, claim 1. The Examiner admitted that Mizzi does not teach or suggest the instant ratio of injection time to stop time, but speculated that in a device claim, parts to the device are essential not the instant ratio of injection time to stop time.

The applicant believes that the Examiner's statements are not accurate and need further clarification. The 35 U.S.C.103(a) rejection of claim 1 is analyzed using MPEP guidelines which are stated in the MPEP Paragraph 2143 as follows:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

All claim limitations are important according to the MPEP guidelines quoted above and the case law, therefore the Examiner statement about less important limitations is not accurate.

Moreover, the reference of Mizzi quoted by the Examiner does not describe many other limitations of claim 1 required by MPEP Paragraph 2143 which is analyzed below in detail.

As essential elements, Claim 22 includes the following limitations:

A: "a cylinder (2) adapted to be secured atop an aerosol can, said cylinder (2) communicating with a pressurized product, in said can, via port (11)",

B: "a hollow piston forming a nozzle (4) and adapted to reciprocate with respect to said cylinder (2)",

C: "a needle (6) adapted to intermittently engage against an inner surface of said hollow piston (5)",

D: "a pressure chamber (20) adapted to receive pressurized product, via said port (11), from said aerosol can",

E: first spring means, and

F: second spring means

On the other hand, Mizzi teaches that "One portion of the reservoir wall 15 is flattened to provide a bearing surface to receive the air compressing pump module 13. The flattened wall 15 is also provided with an elastomeric seal 16. From an examination of FIGS. 2 and 3 of Mizzi it can be seen that the air compressing pump module consists of a container 17 having a needle-like member 18 projecting therefrom. The container 17 is also preferably made with a

curved wall 19 and a flattened wall 20 which is complementary to the wall 15 of the reservoir." (column 2, lines 47 to 57)

From the description of Mizzi, an air compressing pump module is separately provided on the side surface of aerosol can.

Further, Mizzi describes that "When the apparatus is assembled as shown in FIGS. 1 and 3, the air coming through the nozzle 18 will be forced into the reservoir 11 above the liquid 14 contained therein. When sufficient air pressure has been achieved by reason of shaking the assembly, the dispensing nozzle 12 may be pressed in the conventional manner, liquid will be forced up the dip tube 42 and a fine aerosol will be expelled from the nozzle. When air pressure drops within the reservoir 11, it is only necessary to resume the familiar shaking motion to build up sufficient air pressure to resume application of the liquid 14." (column 3, lines 34 to 45)

Moreover, Mizzi discloses that before using the apparatus there is conducted shaking up-and-down motion of the reservoir 11 as well as the air compressing pump module 17 in order to accumulate within the reservoir 11 the pressurized air until reaching the pressure to be expelled. If the pressurized air within the reservoir 11 until reaching the pressure to be expelled is reached, and the dispensing nozzle 12, which is carried at the top of the reservoir, is pushed down, liquid 14 is continuously expelled, and stopped to be expelled if the pressurized air within the reservoir 11 is lowered.

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From the description of Mizzi recited above, it follows that the present invention is quite different from the invention disclosed by Mizzi. In other words, Mizzi does not describe nor suggest the essential elements A, B, C, D, E and F of the present invention with all limitations recited above. Specifically Mizzi does not teach the first spring means 7, the second spring means 8 and the hollow piston 5 recited in claim 22 of the present invention (elements B, E and F). Also other elements A, C and D are not clearly described by Mizzi in light of their unique limitations which are underlined above (see elements A, C and D).

In other words, the Examiner did not establish an equivalence between the elements and their functions taught by Mizzi and the elements A, B, C, D, E and F and their functions recited in claim 22 of the present invention. For example, the needle-like member 18 of Mizzi (assuming it is equivalent to the element C of claim 22 recited above) punctures the elastomer seal 16 "thereby placing the interior pump module 13 in communication with the interior of the reservoir 11 (see col. 2, line 68 to col. 3, line 2 of Mizii), whereas in the present invention a needle 6 is adapted to intermittently engage against an inner surface of the hollow piston 5" which is totally different from teaching of Mizzi. Moreover, the applicant could not clearly identify in teaching of Mizzi equivalent elements of the pressure chamber 20 (element D above) and the cylinder 2 (element A above) recited in the present invention, where both communicate with the pressurized product. The Applicant requests the Examiner to clarify the equivalence of all the elements and their performance

described by Mizzi in reference to claim 22 of the present invention in order to establish a prima facie case of obviousness.

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Furthermore, even if only for the sake of argument we assume that Mizzi teaches or suggests all the limitations of independent claim 22, there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by Mizzi or generally available to one of ordinary skill in the art to modify the reference of Mizzi to arrive at the subject matter of claim 22 of the present invention (as required by the MPEP Paragraph 2143 referenced above and by the case law). The Federal Circuit Court has several times expressly addressed the issue.

For example, *in re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and

combine the references relied on as evidence of obviousness."

The reference of Mizzi quoted by the Examiner does not suggest, discuss or even hint about the solution recited in claim 22 of the present invention, i.e., that the instant ratio of injection time to stop time is set to 0.1 to 5.0.

In other words the Examiner failed to show a *prima facie* case of obviousness because he does not show any basis present in the art at the time of the invention for combining or modifying references (see MPEP paragraphs 2142, 2143 quoted above, and the case law). Therefore, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to modify the reference of Mizzi quoted by the Examiner at the time of the invention and to find the solution claimed by the Applicant in claim 22 without the benefit of hindsight.

Moreover, Mizzi does not provide teaching or suggestion for the reasonable expectation of success by modifying the reference of Mizzi to find the solution claimed by the Applicant in claim 22, as required by the MPEP paragraph 2143, quoted above to establish a *prima facie* case of obviousness.

Thus, based on the above remarks, claim 22 is not obvious under 35 U.S.C. 103(a) as being unpatentable over Mizzi.

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The objections and rejections of the Office Action of March 1, 2006 having been shown to be inapplicable, withdrawal thereof is requested and passage of claims to issue is solicited.

Respectfully submitted,



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